

RESPONSE UNDER 37 C.F.R. § 1.116
U.S. Application No. 09/960,344
Attorney Docket No. Q66385

REMARKS

Reconsideration and allowance of this application are respectfully requested. Claims 1-9 are pending in the application. The rejections are respectfully submitted to be obviated in view of the remarks presented herein.

Rejection Under 35 U.S.C. § 102(b) - Reifman et al.

Claims 1, 2, 4-6, 8 and 9 have been rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Reifman et al. (U.S. Patent Number 5,917,615; hereinafter “Reifman”). The rejection is respectfully traversed.

Regarding claim 1, Applicant’s claimed invention relates to a document transmission apparatus, comprising a document data transmission section, a transmittal letter production section, a transmission section, an additional information storage section, and an operation section. The operation section selects an arbitrary one of a plurality of pieces of additional information stored in the additional information storage section, and the transmittal letter production section produces a transmittal letter in which the additional information selected by the operation section **is inserted**.

Applicant respectfully submits that the disclosure of Reifman does not anticipate the claimed invention. In Reifman, a user selects a data file to be transmitted with the facsimile by selecting the desired file from a list of files. In such a way, **the file is sent with the facsimile transmission as an enclosure** (column 21, lines 33-44).

Therefore, because Reifman’s data file is merely attached as an enclosure, Reifman fails to teach or suggest “an operation section for selecting an arbitrary one of the pieces of additional information from within said additional information storage section; said transmittal letter

RESPONSE UNDER 37 C.F.R. § 1.116
U.S. Application No. 09/960,344
Attorney Docket No. Q66385

production section producing a transmittal letter in which the additional information selected by said operation section is inserted,” as recited in claim 1. Reifman merely attaches a user chosen data file to the facsimile transmission (Figures 15 and 16), and does not insert additional information to the transmittal letter. Reifman’s user chosen data file is not inserted into a transmittal letter. Reifman’s attachment of the data file only results in transmission of the attached file as an attachment/enclosure along with the facsimile message, and such an attachment of the data file does not produce a transmittal letter in with additional information selected from within an additional information storage section is inserted into the transmittal letter, as Applicant claims. Reifman’s attachment of the file is a separate enclosure *with*, and not an insertion *within* a transmittal letter. At least by virtue of the aforementioned differences, Applicant’s claim 1 distinguishes over Reifman. Applicant’s claim 5 relates to a corresponding program on a recording medium for a document transmission apparatus, and is allowable for analogous reasons as discussed above. Applicant’s claims {2, 4 and 8} and {6 and 9} are dependent claims including all of the elements of independent claims 1 and 5, respectively, which, as established above, distinguishes over Reifman. Therefore, claims 2, 4, 6, 8 and 9 are distinguished over Reifman for at least the aforementioned reasons as well as for their additionally recited features. Reconsideration and withdrawal of the rejection under 35 U.S.C. § 102(b) are respectfully requested.

With further regards to claims 2 and 6, the additional information stored in the additional information storage section is displayed on a display section, and the additional information displayed on the display section is arbitrarily selected. Reifman only displays the names of the

RESPONSE UNDER 37 C.F.R. § 1.116
U.S. Application No. 09/960,344
Attorney Docket No. Q66385

files listed, and not information stored (Figures 15 and 16; column 21, lines 24-45). Also, as shown in Figure 14, only the names of the stored cover page style files are displayed, not information (column 20, lines 49-67). The names of the files are not analogous to the “additional information” as claimed, because the additional information is able to be inserted in the claimed transmittal letter. Reifman’s file names are not inserted in a transmittal letter, but rather, the files associated with the file names are attached for transmission along with the outgoing facsimile message, but is never inserted to be part of the message. At least by virtue of these additional differences as well as the aforementioned differences, Applicant’s claimed invention distinguishes over Reifman.

Rejection Under 35 U.S.C. § 103(a) - Reifman et al.

Claims 3 and 7 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Reifman. The rejection is respectfully traversed.

Applicant’s claimed invention relates to document transmission as discussed above. Applicant further recites in claims 3 and 7 that a registration number and a title for each of the pieces of additional information is stored into an additional information storage section, and at least the registration numbers and the titles of the pieces of additional information stored in the additional information storage section is displayed as a list. One of the displayed registration number is additionally designated to select the additional information and a text of the selected additional information is inserted into the transmittal letter.

As previously discussed, Reifman does not teach or suggest an operation section which selects an arbitrary one of pieces of additional information from within an additional information

RESPONSE UNDER 37 C.F.R. § 1.116
U.S. Application No. 09/960,344
Attorney Docket No. Q66385

storage section, and producing a transmittal letter in which the additional information selected by the operation section is inserted. Furthermore, there is no teaching or suggestion in Reifman of the insertion of a text of the selected additional information into the transmittal letter, as claimed. The attachment of a user chosen data file to the facsimile transmission (Figures 15 and 16) solely attaches the data file to the transmission of the facsimile, and does not insert additional information to the transmittal letter. Reifman's file storage unit (28) also only stores file names, which are displayed in a list (Figure 15). There is no teaching or suggestion in Reifman of including a registration number for each piece of additional information, displaying the registration numbers and the titles of the pieces of additional information as a list, and designating one of the displayed registration numbers to select the additional information for insertion of a text of the selected additional information in the transmittal letter, as Applicant claims. Examiner maintains his contention that it would be advantageous to modify Reifman to utilize registration numbers, and that these features are well known in the art and it would have been an obvious modification of the system disclosed by Reifman. However, there has not been any references provided to suggest these elements. Further, Applicant maintains that the Examiner's conclusions of the advantages of using registration numbers are merely hindsight, and there is no motivation apparent in the system of Reifman to designate a registration number to select the additional information.

The Examiner has stated in paragraph 14 on page 6 of the Office Action that "any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning." The reliance on advantages derived from Applicant's own disclosure would be

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U.S. Application No. 09/960,344
Attorney Docket No. Q66385

improper as the basis for an obviousness rejection. Beyond the Applicant's own disclosure, there is no teaching or suggestion of including a registration number for each piece of additional information, displaying the registration numbers and the titles of the pieces of additional information as a list, and designating one of the displayed registration numbers to select the additional information for insertion of a text of the selected additional information in the transmittal letter, as recited in claims 3 and 7. In particular, Reifman fails to teach or suggest these claimed features as recited in the claimed invention.

At least by virtue of the aforementioned differences, Applicant's claims 3 and 7 are patentable over Reifman. Reconsideration and withdrawal of the rejection under 35 U.S.C. § 103(a) are respectfully requested.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

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Attorney Docket No. Q66385

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.


Respectfully submitted,

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